

RESPONSE

Double Patenting

The Examiner has made a rejection based upon the judicially created doctrine of non-statutory double patenting. A terminal disclaimer in compliance with 37 CFR 1.321(c) is submitted herewith to overcome this rejection.

Claim Rejections 35 U.S.C. §102

The Examiner has rejected claims 1, 3, 5, 24, 26, 28 and 29 under 35 USC § 102as being anticipated by Boutle (U.S. Patent No. 4,157,424). Applicant respectfully traverses.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference” *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in complete detail as contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 126, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. MPEP § 2131.

Applicant’s claim 1 elements are 1) combining a polyurethane-containing material with a solvent; 2) forming a solution of the polyurethane-containing material and a solvent; 3) adding a non-solvent to the solution to form a ***suspension in solvent and non-solvent***; and 4) removing the solvent to form a ***suspension of the polyurethane in***

the non-solvent. Carefully read, Boutle expressly states throughout the specification that after the initial solution is formed, a mixture – that is solid enough to be shaped – is formed. Then the polymeric plastics are solidified by leaching out the filler. The filler in Boutle is described as a material having a substantial number of particles having a diameter of less than 100 microns. For example, a water soluble compound, such as a sugar or a salt. Specifically, Boutle's invention comprises a method of making a microporous polymeric plastics material comprising: 1) forming a mixture comprising a solution of polymeric plastics material in an organic solvent, the solution having evenly distributed microscopic particles of removable filler; 2) shaping the mixture; and 3) solidifying the polymeric plastics by the action of a non-solvent, and *leaching out the filler to leave the working material in a microporous solid form.* Boutle's invention does not anticipate Applicant's invention.

“The identical invention must be shown in complete detail as contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 126, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant's claim 1 specifically states that the once the solvent is removed a suspension is formed of the polyurethane-containing material and non-solvent. As well known in the art, a suspension is a heterogeneous mixture in which droplets or particles are suspended in a liquid. Boutle, in Col. 2-3, lines 62-68, 1, states that addition of the leaching agent reduces the solubility of the working material in the solvent thus causing the working material to solidify. The presence of solid filler dispersed through the working material appears to result in rapid and even solidification of the working material with substantially no inclusion of the solvent ...”

Thus, while the invention as disclosed by Boutle forms a solid, Applicant's invention forms a suspension and the goal of Applicant's invention is to form a suspension. That suspension can then be employed in the process of making polyurethane foam materials or it can be used for other purposes as disclosed in the specification. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference" *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Boutle does not disclose each and every claim element. Therefore, Applicants' invention is not anticipated by Boutle.

Claim Rejections – 35 U.S.C. §103

The Examiner has rejected claims 2, 4, 16-20, 25 and 27 under 35 U.S.C. 103(a) as obvious over Boutle (U.S. Patent No. 4,157,424) in view of JP 50-149768 (pending translation). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references *must teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 20 USPQ 1438 (Fed.Cir. 1991); MPEP § 2142. The Examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness.

In order for an obviousness rejection to stand, "the prior art references *must teach or suggest all the claim limitations*." *In re Vaeck*, 20 USPQ 1438 (Fed.Cir. 1991); MPEP § 2142. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested. *In re Royka*, 180 USPQ 580 (CCPA

1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494; MPEP §2143.03.

As stated in the MPEP, if the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under **35 U.S.C. 103**, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. **MPEP § 706.02**. Pending a translation, the Examiner has not made a valid rejection.

In addition, because claims 2, 4, 17-20, 25 and 27 are all dependent claims, because not all claim limitations are not taught or suggested and because claims 1, 16 and 23 are independent claims, all claims depending therefrom are nonobvious. If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

Again, in order for an obviousness rejection to stand, “the prior art references *must teach or suggest all the claim limitations.*” *In re Vaeck*, 20 USPQ 1438 (Fed.Cir. 1991); MPEP § 2142. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested. *In re Royka*, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494; MPEP §2143.03.

The Examiner has rejected claims 6-15 and 21-31 under 35 U.S.C. §102 as being anticipated or, ~~in~~ the alternative, under 35 U.S.C. 103(a) as obvious over Boutle (U.S. Patent No. 4,157,424) in view of Dietrich (U.S. Patent No. 3,939,222). Applicant respectfully traverses this rejection.

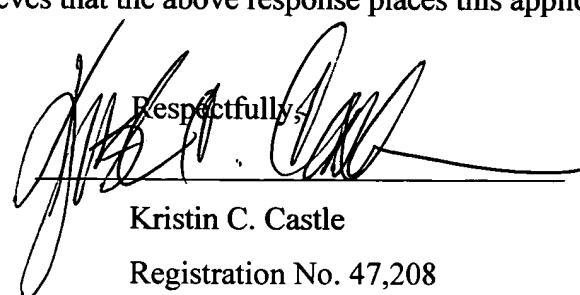
The Examiner has rejected claim 23, an independent claim in view of the above referenced patents. As stated in **MPEP § 706.02**, if the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. Thus, the rejection is not valid until a translation of Dietrich is obtained.

Claims 6-15, 21, 22 and 24-32 are dependent claims and, because not all claim limitations are not taught or suggested, and because claims 1, 16 and 23 are independent claims, all claims depending therefrom are nonobvious. If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

CONCLUSION

Applicant respectfully believes that the above response places this application in condition for allowance.

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Respectfully,
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